

Remarks

I. Status of claims

Claims 1-21 were pending.

Previously withdrawn claims 18-20 have been canceled.

Claims 22-25 have been added.

II. Claim rejections under 35 U.S.C. § 102(b)

A. Claim rejections over Sharpe

The Examiner has rejected claims 1-4, 11, 14, and 15 under 35 U.S.C. § 102(b) over Sharpe (U.S. 2,788,852). Claim 1 is an independent claim and claims 2-4, 11, 14, and 15 depend from independent claim 1.

With regard to independent claim 1, the Examiner has indicated that:

Sharpe discloses an apparatus which includes a sheet material dispenser configured to dispense a sheet material (Figures 1 and 2, pressure sensitive adhesive tape 30) having one of multiple effective widths (column 2, lines 37-40). It is noted that the limitation stating that the system is "for binding sheets into bound text bodies having respective spines exposed for adhesive application and characterized by multiple length dimensions and multiple thickness dimensions" is a recitation of the apparatus' intended use and that the apparatus disclosed by Sharpe would be capable of dispensing a solid adhesive sheet across the thickness dimension of a text body spine, thereby meeting the limitations of the present claim.

Claim 1 has been amended and now recites that the system is a bookbinding system that comprises a sheet collector configured to assemble a text body from multiple sheets, and that the adhesive dispenser is positioned to receive an assembled text body from the sheet collector and configured to dispense solid sheet adhesive across the thickness dimension of the a text body spine. Sharpe does not teach or suggest anything about bookbinding, much less anything about a bookbinding system that includes a sheet collector and an adhesive dispenser as now recited in claim 1. In addition, Sharpe does not provide any teaching that

would have led one of ordinary skill in the art at the time of the invention to attempt to use his manually-operated pressure sensitive tape dispenser to bind sheets into bound text bodies.

For at least these reasons, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 102(b) over Sharpe now should be withdrawn.

Claims 2-4, 11, 14, and 15 incorporate the features of independent claim 1 and therefore are patentable over Sharpe for at least the same reasons explained above.

B. Claim rejections over McLane

The Examiner has rejected claims 1, 14-16, and 21 under 35 U.S.C. § 102(b) over McLane (U.S. 3,296,911).

With regard to independent claim 1, the Examiner has indicated that:

McLane discloses an apparatus which includes a sheet material dispenser configured to dispense a sheet material (Figure 1, material 30) having one of multiple effective widths (column 3, lines 58-61). It is noted that the limitation stating that the system is "for binding sheets into bound text bodies having respective spines exposed for adhesive application and characterized by multiple length dimensions and multiple thickness dimensions" is a recitation of the apparatus' intended use and that the apparatus disclosed by Sharpe would be capable of dispensing a solid adhesive sheet across the thickness dimension of a text body spine, thereby meeting the limitations of the present claim.

Claim 1 has been amended and now recites that the system is a bookbinding system that comprises a sheet collector configured to assemble a text body from multiple sheets, and that the adhesive dispenser is positioned to receive an assembled text body from the sheet collector and configured to dispense solid sheet adhesive across the thickness dimension of the a text body spine. McLane does not teach or suggest anything about bookbinding, much less anything about a bookbinding system that includes a sheet collector and an adhesive dispenser as now recited in claim 1. In addition, McLane does not provide any teaching that would have led one of ordinary skill in the art at the time of the invention to attempt to use his insulating material severing apparatus to bind sheets into bound text bodies.

For at least these reasons, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 102(b) over McLane now should be withdrawn.

Claims 14-16 and 21 incorporate the features of independent claim 1 and therefore are patentable over McLane for at least the same reasons explained above. Claim 21 also is patentable over McLane for the following additional reason.

Claim 21 recites that adhesive dispenser is configured to automatically advance the solid sheet adhesive beyond the location cut by the width cutter, and to automatically cut across the solid sheet adhesive with the length cutter to prepare a clean leading edge free of any cuts by the width cutter for a subsequent sheet binding. McLane teaches that "it is contemplated as being within the scope of the present invention to provide automatic means for selectively advancing material 30 through the longitudinal cutting assembly 24 and then automatically transversely severing the slit material by a motorized transverse cutting assembly" (col. 5, lines 17-21). McLane, however, does not teach or suggest that his severing apparatus is configured to automatically advance the material 30 beyond the location cut by the cutter assembly 24, and to automatically cut across the material 30 with the transverse cutter assembly 54 to prepare a clean leading edge free of any cuts by the cutter assembly 24. In addition, McLane fails to teach anything that would have motivated one of ordinary skill in the art at the time of the invention to configure his severing apparatus in such a way. Indeed, in the context of the severing applications contemplated by McLane for his severing apparatus, there is no apparent benefit that could have been gained by such a modification.

For at least this additional reason, the Examiner's rejection of claim 21 under 35 U.S.C. § 102(b) over McLane now should be withdrawn.

III. Claim rejections under 35 U.S.C. § 103(a)

For the purpose of the following discussion, the examiner is reminded that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, and not on applicants' disclosure.

MPEP § 706.02(j) (emphasis added). Furthermore, as pointed out by the Patent Office Board of Appeals and Interferences:

The examiner should be aware that "deeming" does not discharge [her] from the burden of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of obviousness.

Ex parte Stern, 13 USPQ2d 1379 (BPAI 1989).

A. Claim 1

The Examiner has rejected claim 1 under 35 U.S.C. § 103(a) over Dim (U.S. 6,460,843) in view of Sharpe (U.S. 2,788,852) and McLane (U.S. 3,296,911). In particular, the Examiner has indicated that (emphasis added):

Dim et al. discloses an apparatus which includes a sheet material dispenser configured to dispense a sheet material (Figure 8A, glue roll 98) having a given width. Dim et al. do not disclose an apparatus in which the sheet material has one of multiple effective widths. It is well know and conventional in the sheet material dispensing art, as disclosed by Sharpe (column 2, lines 37-40) and McLane (column 3, lines 28-32), to provide a sheet material dispenser with adjustable longitudinal cutters to provide sheet material segments having a range of widths. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Dim et al. to include width adjustability for the sheet material as suggested by Sharpe and McLane to provide sheet material segments which are customized to correspond to the size of the article, i.e., book spines, to which it is being applied.

In her rejection, the Examiner has failed to establish a proper *prima facie* case of obviousness. As explained above, to establish a proper *prima facie* case of obviousness the "teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not on applicants' disclosure" (MPEP § 706.02(j)).

The Examiner's asserted reason for modifying Dim's finishing machine is "to provide sheet material segments which are customized to correspond to the size of the article, i.e., book spines, to which it is being applied." The Examiner, however, has failed to point to any location in any of the cited references where this asserted motivation is taught or suggested. Indeed, none of the cited references provides even a hint of such a teaching or suggestion. To the contrary, the Examiner has acknowledged that Dim fails to teach or suggest an adhesive dispenser configured to dispense across the thickness dimension of a text body spine solid sheet adhesive having one of multiple effective widths sized to correspond substantially to the length dimension of the text body spine. In addition, neither Sharpe nor McLane teaches or suggests anything about bookbinding, much less anything about cutting an adhesive sheet to a customized width corresponding to the length dimension of a text body spine. It therefore appears that the Examiner has engaged in impermissible hindsight reconstruction of the claimed invention, using the structure recited in claim 1 as a template and selecting elements from the cited references to fill in the gaps.

In addition, contrary to the Examiner's assertion, Dim's finishing machine does not include an adhesive dispenser configured to dispense solid sheet adhesive across the thickness dimension of the spine of a text body received from a sheet collector, as now recited in claim 1. In Dim's finishing system, a glue strip 96 is cut from glue roll 98 and *applied to cover 19* (see, e.g., col. 7, lines 43-45); the glue strip 96 is *not* dispensed across the thickness dimension of the spine of a text body received from a sheet collector. Since none of the cited references describes a bookbinding system that includes an adhesive dispenser that is configured to dispense solid sheet adhesive across the thickness dimension of the spine of a text body received from a sheet collector, no permissible combination of the cited references possibly could teach such a bookbinding system.

For at least these reasons, the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) over Dim in view of Sharpe and McLane should be withdrawn.

It is noted that, contrary to the Examiner's assertion that Applicants' arguments have been considered, the Examiner has failed to address Applicants' points regarding the failings of Dim's teachings. Instead, the Examiner merely has copied verbatim her assertions from the prior rejection of claim 1. If the Examiner relies on the teachings of Dim in her next action, Applicants request that the Examiner give due consideration of and respond directly to Applicants' arguments regarding the failings of Dim's teachings.

B. Claims 2, 5-7, 11, and 12

The Examiner has rejected claims 2, 5-7, 11, and 12 under 35 U.S.C. § 103(a) over Dim in view of Sharpe, McLane, and Mallonee (U.S. 5,460,672).

Each of claims 2, 5-7, 11, and 12 incorporates the features of independent claim 1. Mallonee fails to make up for the failure of Dim, Sharpe, and McLane to teach or suggest a bookbinding system that includes an adhesive dispenser that is configured to dispense solid sheet adhesive across the thickness dimension of the spine of a text body received from a sheet collector. Accordingly, claims 2, 5-7, 11, and 12 are patentable for at least the same reasons explained above in section III.A.

With regard to combining the teachings of Dim and Mallonee, the Examiner has indicated that:

... Dim et al. do not disclose a system in which the adhesive dispenser is configured to dispense multiple segments of solid sheet adhesive. Mallonee discloses a web material dispenser (Figure 7) which is configured to independently dispense multiple segments of sheet material along a length dimension. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the adhesive sheet dispenser of Dim et al. to independently dispense and join multiple segments of standard sized solid sheet adhesive webs as suggested by Mallonee to accommodate the length of oversized books.

MPEP § 2141.01(a) recites that:

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.

According to Mallonee, his disclosure "relates to the field of equipment and methods for making textile fabrics, and more particularly, to an apparatus and method for making a relatively wide textile fabric from a plurality of textile webs joined together in side-by-side relative" (col. 1, lines 6-10). The field of making textile fabrics clearly is not the same as the field of binding sheets into bound text bodies. In addition, the field of making textile fabrics is not reasonably pertinent to the problem of binding sheets into bound text bodies with a

system that includes an adhesive dispenser configured to dispense solid sheet adhesive across the thickness dimension of a text body spine, which is the subject of the invention recited in claims 2-6, 11, and 12. Indeed, solid sheet adhesive is not used in the field of making relatively wide textile fabric webs, "such as nonwoven textile webs used for bedding products" (col. 1, lines 15-16). Accordingly, a person of ordinary skill, seeking to solve a problem of binding sheets into bound text bodies with solid sheet adhesive, would not reasonably be expected or motivated to look to apparatus and methods for making textile fabrics, even in the case suggested by the Examiner of "binding oversized books."

For at least this additional reason, the Examiner's reliance on Mallonee in the rejection of claims 2, 5-7, 11, and 12 is improper and the Examiner's rejection of these claims under 35 U.S.C. § 103(a) over Dim in view of Sharpe, McLane, and Mallonee should be withdrawn.

In addition, the improper combination of Dim and Mallonee proposed by the Examiner would not teach or suggest all of the limitations recited in these claims. Indeed, each of claims 2, 5-7, 11, and 12 requires that the adhesive dispenser be "configured to dispense multiple segments of solid sheet adhesive along the length dimension of the text body spine." The Examiner has relied on the teaching of Mallonee to make up for Dim's failure to teach or suggest such a feature. Mallonee's textile web joining apparatus, however, does not *dispense multiple segments* of textile webs, contrary to the Examiner's assertion. Indeed, the entire purpose of Mallonee's invention is to *join* a plurality of textile webs together in side-by-side relation into *a single textile web*. Furthermore, Mallonee's textile web joining apparatus is not configured to dispense a sheet across the thickness dimension of a text body spine. Rather, Mallonee's textile web joining apparatus is suitable only for taking up the resulting joined textile web in a roll. Therefore, contrary to the Examiner's assertion, the combination of Dim and Mallonee hardly would teach or suggest a dispenser that is configured to dispense multiple segments of solid sheet adhesive.

For at least this additional reason, the Examiner's rejection of claims 2, 5-7, 11, and 12 under 35 U.S.C. § 103(a) over Dim in view of Sharpe, McLane, and Mallonee should be withdrawn.

It is noted that, contrary to the Examiner's assertion that Applicants' arguments have been considered, the Examiner has failed to address Applicants' points regarding the failings of Mallonee's teachings. Instead, the Examiner merely has copied verbatim her assertions

from the prior rejection of claims 2, 5-7, 11, and 12. If the Examiner relies on the teachings of Mallonee in her next action, Applicants request that the Examiner give due consideration of and respond directly to Applicants' arguments regarding the failings of Mallonee's teachings.

C. Claim 8

The Examiner has rejected claim 8 under 35 U.S.C. § 103(a) over Dim, Sharpe, McLane, Mallonee, and Nakamura (U.S. 5,842,691).

Dependent claim 8 incorporates the features of claims 1, 2, 6, and 7 and therefore is patentable for at least the same reasons explained above. Claim 8 also is patentable for the following additional reason.

Claim 8 requires that the adhesive dispenser comprise "a motor for driving the drive shaft, and a clutch disposed between a pair of drive rollers [that] enables one or both drive rollers of the drive roller pair to be driven selectively by the motor." The Examiner has relied on the teaching of Nakamura to make up for the failure of Sharpe, McLane, Mallonee, and Dim to teach or suggest such a feature. In particular, the Examiner has indicated that:

It is well known and conventional in web handling apparatus art, as disclosed by Nakamura (column 7, lines 21-25), to use a motor for driving the drive shaft and a clutch for enabling the drive rollers to be driven by the motor.

The feed clutch 72 in the feed roll system that is shown in FIG. 5 of Nakamura, however, does not include a clutch disposed between a pair of drive rollers that enables one or both drive rollers of the drive roller pair to be driven selectively by the motor, as recited in claim 8. Moreover, Nakamura's image formation apparatus (i.e., copier) is designed to feed single, complete sheets of paper, not multiple segments of solid sheet adhesive. Accordingly, there would be no motivation to modify Nakamura (or any of the other cited references) to include a clutch disposed between a pair of drive rollers that enables one or both drive rollers of the drive roller pair to be driven selectively by the motor, as recited in claim 8. Since none of the cited references teaches or suggests this feature of claim 8, no permissible combination of these references would teach or suggest such a feature.

For at least this additional reason, the Examiner's rejection of claim 8 under 35 U.S.C. § 103(a) over Dim, Sharpe, McLane, Mallonee, and Nakamura should be withdrawn.

It is noted that, contrary to the Examiner's assertion that Applicants' arguments have been considered, the Examiner has failed to address Applicants' points regarding the failings of Nakamura's teachings. Instead, the Examiner merely has copied verbatim her assertions from the prior rejection of claim 8. If the Examiner relies on the teachings of Nakamura in her next action, Applicants request that the Examiner give due consideration of and respond directly to Applicants' arguments regarding the failings of Nakamura's teachings.

D. Claim 9

The Examiner has rejected claim 9 under 35 U.S.C. § 103(a) over Sharpe in view of Kuhns (U.S. 3,953,277) and Steinberg (U.S. 6,129,796).

Dependent claim 9 incorporates the features of claims 1 and 2 and therefore is patentable for at least the same reasons explained above. Claim 9 also is patentable for the following additional reasons.

Claim 9 further requires an adhesive quantity interrogator configured to obtain indications of the length of each solid sheet adhesive segment remaining in a plug-in cartridge housing. The Examiner has relied on the teachings of Kuhns and Steinberg to make up for the failure of Sharpe to teach or suggest such a feature. In particular, the Examiner has indicated that:

Kuhns discloses a bookbinding apparatus which includes a plug-in cartridge housing (Figure 1, cartridge 57) containing a roll of solid sheet adhesive (Figure 1, adhesive bearing strip 30). It is well known and conventional in the material dispensing art, as disclosed by Steinberg et al. (column 8, lines 51-53), to use a quantity interrogator to determine the remaining amount of material on a spool. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the apparatus of Sharpe with a plug-in cartridge housing as suggested by Kuhns to ease replenishment of the adhesive sheet material and an adhesive quantity interrogator configured as suggested by Steinberg et al. to obtain indications of the length of each solid sheet adhesive segment remaining in a plug-in cartridge housing.

Kuhns merely discloses a bookbinder that is configured to dispense a single strip of adhesive from a cartridge 57. Kuhns does not teach or suggest anything about dispensing multiple segments of solid sheet adhesive along the length dimension of a text body spine.

Steinberg discloses a system and method for dispensing and labeling a length of cord, "such as rope cable, wire, chain and electrical cord" (col. 1, line 25). Steinberg's dispensing system, like Kuhn's adhesive cartridge, merely dispensing a single element; Steinberg does not teach or suggest anything about dispensing multiple cords from a spool, much less anything about dispensing multiple segments of solid sheet adhesive. Moreover, contrary to the Examiner's assertion, Steinberg does not teach or suggest anything about a "quantity interrogator [that is configured] to determine the remaining amount of material on a spool." The only disclosure in Steinberg relating to determining the remaining amount of material on a spool is as follows (col. 4, lines 7-14):

The spool 26 may also carry a visual indication for displaying the approximate amount of cord left on spool. For example, as shown in FIG. 8, spool 26 may include a colored, pie shaped portion 29 having markings, preferably 1/4, 1/2 and 3/4 for indicating how much of the cord is left on the spool. Alternatively, the visual indication may include other shapes, such as a thermometer, etc., as would be known to one of skill in the art.

That is, Steinberg's cord dispensing system does not include a "quantity interrogator [that is configured] to determine the remaining amount of material on a spool," as asserted by the Examiner. Instead, in Steinberg's approach, the cord spool merely includes a marking that provides a visual indication to a user how much cord remains on a spool.

In sum, none of the cited references teaches or suggests a quantity interrogator configured to obtain an indication of the length of material remaining in a plug-in cartridge housing, nor do any of the references teach or suggest anything about an adhesive quantity interrogator configured to obtain an indication of the length of each of multiple solid sheet adhesive segments remaining in a plug-in cartridge housing. Accordingly, no permissible combination of the cited references could teach or suggest these features of claim 9.

For at least these additional reasons, the Examiner's rejection of claim 9 under 35 U.S.C. § 103(a) over Sharpe in view of Kuhns and Steinberg should be withdrawn.

It is noted that, contrary to the Examiner's assertion that Applicants' arguments have been considered, the Examiner has failed to address Applicants' points regarding the failings of Kuhns' and Steinberg's teachings. Instead, the Examiner merely has copied verbatim her assertions from the prior rejection of claim 9. If the Examiner relies on the teachings of Kuhns and Steinberg in her next action, Applicants request that the Examiner give due

consideration of and respond directly to Applicants' arguments regarding the failings of Kuhns' and Steinberg's teachings.

E. Claim 10

The Examiner has rejected claim 10 under 35 U.S.C. § 103(a) over Sharpe in view of Kuhns, Steinberg, and Whiteman (U.S. 3,582,010).

Dependent claim 10 incorporates the features of claims 1, 2, and 9 and therefore is patentable for at least the same reasons explained above. Claim 10 also is patentable for the following additional reasons.

Claim 10 further requires "a controller configured to transmit a warning message when any of the solid sheet adhesive segments is nearly spent." The Examiner has relied on the teachings of Whiteman to make up for the failure of Sharpe, Kuhns, and Steinberg to teach or suggest such a feature. In particular, the Examiner has indicated that:

It is well known and conventional in the material dispensing art, as taught by Whiteman (column, 6, lines 43-50), to use a controller to detect when a material supply is almost depleted. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the apparatus of Luhman with a conventional controller as suggested by Whiteman to detect and alert a user of the depletion of the adhesive sheet supply.

Whiteman's disclosure relates to an apparatus for making a strip conductor coil from a ribbon or strip of electrically conductive material. The field of making electrically conducting ribbon coils is not the same as the field of binding sheets into bound text bodies. In addition, the field of making ribbon coils is not reasonably pertinent to the problem of binding sheets into bound text bodies with a system that includes an adhesive dispenser configured to dispense solid sheet adhesive across the thickness dimension of a text body spine, which is the subject of the invention recited in claim 10. Indeed, solid sheet adhesive is not used in the field of making electrically conducting ribbon coils. Accordingly, a person of ordinary skill, seeking to solve a problem of binding sheets into bound text bodies with solid sheet adhesive, would not reasonably be expected or motivated to look to apparatus and methods for making ribbon coils.

For at least this reason, the Examiner's reliance on Whiteman in the rejection of claim 10 is improper. Since the Examiner has acknowledged that the other cited references fail to teach or suggest the invention recited in claim 10, the Examiner's rejection of claim 10 under 35 U.S.C. § 103(a) over Sharpe, Kuhns, Steinberg, and Whiteman should be withdrawn.

In addition, contrary to the Examiner's assertion, Whiteman fails to teach or suggest "a controller configured to transmit a warning message when any of the solid sheet adhesive segments is nearly spent," as recited in claim 10. In the section of Whiteman cited by the Examiner (col. 6, lines 43-50), Whiteman merely teaches that the coil winding station operates at a substantially constant speed until the ribbon supply roll is nearly completely unwound, at which point the coil winding station operates at a substantially reduced "jog" speed. No "warning message" is transmitted by Whiteman's coil winding station. Accordingly, none of the cited references teaches or teaches this feature of claim 10.

For at least these additional reasons, the Examiner's rejection of claim 10 under 35 U.S.C. § 103(a) over Sharpe, Kuhns, Steinberg, and Whiteman should be withdrawn.

It is noted that, contrary to the Examiner's assertion that Applicants' arguments have been considered, the Examiner has failed to address Applicants' points regarding the failings of Whiteman's teachings. Instead, the Examiner merely has copied verbatim her assertions from the prior rejection of claim 10. If the Examiner relies on the teachings of Whiteman in her next action, Applicants request that the Examiner give due consideration of and respond directly to Applicants' arguments regarding the failings of Whiteman's teachings.

F. Claim 13

The Examiner has rejected claims 13 under 35 U.S.C. § 103(a) over Dim, Sharpe, McLane, Mallonee, and Kuhns.

Dependent claim 13 incorporates the features of claims 1, 2, and 12 and therefore is patentable for at least the same reasons explained above. Claim 13 also is patentable for the following additional reason.

Claim 13 requires that the adhesive dispenser be "configured to position a plug-in cartridge housing containing a roll of solid sheet adhesive at multiple locations along the length dimension of the text body spine." The Examiner has relied on the teachings of Kuhns

and Steinberg to make up for the failure of Dim, Sharpe, McLane, and Mallonee to teach or suggest such a feature. In particular, the Examiner has indicated that:

Kuhns discloses a bookbinding apparatus which includes an adhesive dispenser configured to position a plug-in cartridge housing (Figure 1, cartridge 57) containing a roll of solid sheet adhesive (Figure 1, adhesive bearing strip 30) along the text body spine.

Kuhns merely discloses a bookbinder that is configured to dispense a single strip of adhesive from a cartridge 57. Kuhns does not teach or suggest anything about positioning a plug-in cartridge housing at multiple locations along the length dimension of the text body spine. In Kuhn's bookbinder, cartridge 57 remains stationary. Indeed, cartridge 57 dispensing adhesive in the direction of the length dimension of the stack of paper sheets 17. Accordingly, positioning cartridge 57 at multiple locations would not serve any useful purpose.

For at least this additional reason, the Examiner's rejection of claim 13 under 35 U.S.C. § 103(a) over Dim, Sharpe, McLane, Mallonee, and Kuhns should be withdrawn.

It is noted that, contrary to the Examiner's assertion that Applicants' arguments have been considered, the Examiner has failed to address Applicants' points regarding the failings of Kuhns's teachings. Instead, the Examiner merely has copied verbatim her assertions from the prior rejection of claim 13. If the Examiner relies on the teachings of Kuhns in her next action, Applicants request that the Examiner give due consideration of and respond directly to Applicants' arguments regarding the failings of Kuhns's teachings.

G. Claim 17

The Examiner has rejected claims 17 under 35 U.S.C. § 103(a) over Sharpe in view of Mallonee and Leifeld (U.S. 4,839,943).

Dependent claim 17 incorporates the features of claims 1 and 14 and therefore is patentable for at least the same reasons explained above.

Claim 17 requires that the adhesive dispenser comprise "a waste reservoir configured to store excess solid sheet adhesive cut by the width cutter. The Examiner has relied on the teachings of Leifeld to make up for the failure of Sharpe and Mallonee to teach or suggest such a feature. In particular, the Examiner has indicated that:

It is well known and conventional in the waste material handling art, as disclosed by Leifeld (Figure 1, waste container 15), to provide a container for storing waste materials. When modifying the apparatus of Luhman et al. as noted above to include a width cutter, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the adhesive dispenser with a waste reservoir as suggested by Leifeld for storing the excess trimmed solid sheet adhesive.

According to Leifeld, his "invention relates to an apparatus for detecting foreign bodies such as foreign fibers, tying strings, bands of synthetic material, wire pieces and the like within or between textile fiber tufts, particularly cotton and/or synthetic fiber tufts" (col. 1, lines 6-10). The field of detecting foreign bodies in textile fiber tufts is not the same as the field of binding sheets into bound text bodies. In addition, the field of detecting foreign bodies in textile fiber tufts is not reasonably pertinent to the problem of binding sheets into bound text bodies with a system that includes an adhesive dispenser configured to dispense solid sheet adhesive across the thickness dimension of a text body spine, which is the subject of the invention recited in claim 17. Indeed, solid sheet adhesive is not used in the field of detecting foreign bodies in textile fiber tufts. Accordingly, a person of ordinary skill, seeking to solve a problem of binding sheets into bound text bodies with solid sheet adhesive, would not reasonably be expected or motivated to look to apparatus and methods for detecting foreign bodies in textile fiber tufts.

For at least this reason, the Examiner's reliance on Liefeld in the rejection of claim 17 is improper. Since the Examiner has acknowledged that the other cited references fail to teach or suggest the invention recited in claim 17, the Examiner's rejection of claim 17 under 35 U.S.C. § 103(a) over Sharpe in view of Mallonee and Leifeld should be withdrawn for this additional reason.

It is noted that, contrary to the Examiner's assertion that Applicants' arguments have been considered, the Examiner has failed to address Applicants' points regarding the failings of Leifeld's teachings. Instead, the Examiner merely has copied verbatim her assertions from the prior rejection of claim 17. If the Examiner relies on the teachings of Leifeld in her next action, Applicants request that the Examiner give due consideration of and respond directly to Applicants' arguments regarding the failings of Leifeld's teachings.

IV. Conclusion

Applicant : John P. Ertel et al.
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For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

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